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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/655,136	05/30/1996	BRUCE TOGNAZZINI	2860-014	8272
22852	7590	11/04/2003	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/655,136

Applicant(s)

TOGNAZZINI, BRUCE

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-10,15 and 21-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-10,15 and 21-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Status of Claims

1. Claims 1, 5-10, 15 and 21-28 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5-10 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is directed a portable device. A limitation of the claim recites a docking port for loading information into the portable device's memory. However, the docking port is not part of the portable device (Applicant's figure 1). Neither, is the telephone set (Applicant's figure 1). Therefore, the Applicant has not clearly defined the subject matter that the Applicant regards as the invention.

Claims 6-10 are also rejected as they depend from claim 5.

Claim 28 is rejected as the claim recites performing "sending information stored in said seller memory from said telephone at the seller site to said customer memory for use during a subsequent order" steps without first connecting to a user's telephone (Specification, page/line 14/23-16/10). In

general, the claim does not provide one of ordinary skill a method for transferring data between customer and seller telephones. Specifically, the claim should recite an initiation of contact, a call or the like for enabling data to be transferred between devices.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose et al., U.S. Patent No. 5,757,917 in view of Sandig et al., U.S. Patent No. 5,737,610 and Remillard, U.S. Patent No. 5,396,546.

As per claims 1 and 21, Rose et al. teach a system for purchasing goods and services over the internet comprising: a telephone set connected to a telephone line (column 2, lines 50-62), a data interface connected to a telephone line (figures 1-3; column 2, lines 50-62; column/line 4/66-5/13), data memory for storing card information from a called station and a key for activating said data memory to send stored information to another called station (figure 1; column/line 7/35-8/25; column 8, lines 58-67). Rose et al. do not explicitly recite a card

reader and loading data from a data memory to a portable device. Sandig et al. teach downloading data from a called station over a telephone line, storing the data in data memory, and transferring the information from data memory, using a docking port, to a portable device having device memory (abstract; figure 1).

Remillard teaches a telephone set connected to a telephone line with a data interface, data memory, a docking port for receiving electronic devices (abstract; figures 1-3 and 6A-B; column/line 5/56-6/61; column 8, lines 38-60) and a card reader for accessing goods and services online (column 3, lines 17-33).

Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Rose et al. Sandig et al. and Remillard. Rose et al. teach a user obtaining goods and services from an internet warehouse over a telephone network using a credit card ('917, column 8, lines 1-12), to one of ordinary skill it would have been obvious to make the entering of credit card data more efficient by automating the process through the use of a card reader attached to the telephone set of Rose ('917, column 2, lines 50-62; '546, figures 1-3 and 6A-B).

Further, by incorporating the teachings of Sandig et al. a user can access and download data at using a telephone set connected to a telephone line ('610, column 2, lines 35-50; '917, column 2, lines 50-62; '546, figures 1-3 and 6A-B) for use in another electronic device or devices ('610, column 3, lines 32-55).

Art Unit: 3621

6. Claims 15 and 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bezos, U.S. Patent No. 5,715,399 in view of Bezos, U.S. Patent No. 5,727,163 and Dedrick, U.S. Patent No. 5,717,923.

As per claims 15 and 28, Bezos ('399) teaches a method for sending and receiving goods comprising: providing a telephone having a customer memory at a customer site for storing and sending information (figures 1 and 2) and connecting, by a telephone network, a telephone at a customer site with a telephone at a seller site while an order for goods is placed (abstract; column 5, lines 23-45) and storing in a seller memory of a telephone at a seller site, information provided by said customer (figure 3). Bezos ('399) doesn't specifically recite how the customer information was entered into the system. Bezos ('163) teaches customer information keyed in by personnel at a seller site (column 7, lines 23-50; column 9, lines 43-60). Bezos ('399) also doesn't explicitly teach confirming whether a customer's telephone is memory equipped. Dedrick teaches a system for providing customized information over a network to a user comprising confirming, on a display, properties of device memory and sending information stored in seller memory for use during a subsequent order (column 4, lines 32-65; column 11, lines 45-61; column 12, lines 26-40; column 16, lines 40-51). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Bezos ('399), Bezos ('163) and Dedrick. Bezos ('399) teaches a system for sending and receiving orders for goods where a customer has

Art Unit: 3621

previously placed at least one order, utilizing a secure protocol for exchanging credit card data between buyer and seller ('399, column 5, lines 24-31). Bezos ('163) provides a method for a seller to initially receive credit card data where the received data is keyed into a database for future use ('163, abstract; column 9, lines 44-60). Bezos ('399) also teaches confirming a credit card transaction comprising a seller sending an e-mail to buyer ('399, column 6, lines 19-50). Specifically, Bezos ('399) teaches an e-mail confirmation message that includes an advertisement ('399, column 6, lines 28-40). Dedrick teaches a method of providing users with customized advertisements based on a user profile and/or users variables ('923, column 11, lines 45-61; column 12, lines 26-40). One of the user characteristics that a seller can monitor is how the user consumes or processes electronic information (e.g. advertisements- '923, column 14, lines 52-54) such as audio, video, graphics, animation, text, etc. ('923, column 4, lines 44-55; column 5, lines 42-49; column 6, lines 33-52 and 60-63; column 11, lines 45-61). Therefore, it would have been obvious to one of ordinary skill to identify a customer's capabilities for consuming electronic information (e.g. whether a telephone is customer equipped) and provide advertisements to a user in the appropriate format and/or select out users who use a particular processing device (e.g. memory) and send advertisements to only those users ('923, column 5, lines 34-49; column 11, lines 45-61).

7. Claims 5-10 and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feldman, U.S. Patent No. 5,343,519 in view of Winebaum et al., U.S. Patent No. 4,941,172.

As per claims 5-10 and 22-27, Feldman teaches a portable device with memory (figure 3), a docking port for receiving card information from an external memory and received from a seller memory (figure 4; column 4, lines 41-62), where the device comprises: a converter for converting information from said device memory into an audible representation of the information (abstract), a send key for activating said converter and transmitting the audible representation, via a microphone of a telephone set, to a called station (column 4, lines 6-17), a plurality of keys for controlling a plurality of device memories each selectively storing data (figure 3; column 4, lines 25-41), a display for showing the contents of the device memory (figure 3), a digital to analog converter and an electro-acoustical transducer (figures 1-3), a plurality of keys for entering a password prior to loading information into said device and prior to activating said converter (column 2, lines 12-32; column 4, lines 35-55). Feldman does not specifically recite phone purchases. Winebaum et al. teach a pre-programmed portable device with memory that converts information from said device memory into an audible representation of the information and transmits the audible representation, via a microphone of a telephone set to a called station (abstract; column 2, lines 41-65). The portable device can be a credit card

(column 2, lines 36-48) and used to make a telephone purchase (e.g. purchasing a telephone or obtaining goods and services via telephone) (column 3, lines 35-50; column 8, lines 52-67). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Feldman and Winebaum et al. in order to allow users to efficiently connect with service providers ('172, column 1, lines 16-23).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Cox teaches a programmable pen for producing telephonic sound tones
- Cleveland et al. teach a portable data terminal that is attachable to a telephone for performing securities transactions
- Brooks et al. teach an electronic device with a card reader for accessing goods and services online
- Nagata et al. teach a voice recording credit or IC card

Art Unit: 3621

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:


(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Loyd Hewitt II

October 28, 2003



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